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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 144

JOHN G. KURZEN, JR., PETITIONER

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The District Court's brief memorandum opinion (R. 8) is unreported. The Court of Appeals affirmed in a *per curiam* opinion (R. 54), which is reported at 188 F. 2d 673.

JURISDICTION

The judgment of the Court of Appeals was filed on March 29, 1951 (R. 55). The petition for a writ of certiorari was filed on June 25, 1951. The juris-

diction of this Court is invoked under 24 U.S.C. § 1254(1).

QUESTION PRESENTED

The sole question presented is whether petitioner's design for a certain box or casing for a phonograph exhibits sufficient invention to entitle petitioner to a design patent.

STATUTES INVOLVED

The pertinent provisions of R.S. 4929, 35 U.S.C. 73, relating to design patents, are as follows:

> Any person who has invented any new, original, and ornamental design for an article of manufacture * * * may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor.

STATEMENT

Petitioner applied for a design patent on a casing or cabinet, used for housing a portable phonograph. The casing is described as "essentially square in conformation but having a thickness substantially less than the other dimensions. The casing is provided with rounded corners, two side-by-side grilles near the top of one of the larger faces, and a handle folded into one of the edges" (R. 6). A sketch of this box appears at page 46 of the Record. A Patent Office examiner recommended rejection of the application for want of

invention. The Patent Office Board of Appeals affirmed the action of the examiner and the Commissioner rejected the application. Petitioner then brought suit in the District Court, pursuant to R.S. 4915, 35 U.S.C. 63, to compel the Commissioner to issue the patent. The District Court, after hearing evidence, held the design unpatentable and dismissed the suit. Petitioner appealed to the Court of Appeals. The Court of Appeals rejected his contentions and affirmed the judgment of dismissal.

The holding by the District Court of lack of invention was based on anticipation in the prior art. Evidence of the prior art took the form, among other things, of pictures in various electrical equipment catalogues, one of which was a portable radio case, manufactured by the Harrison Wholesale Co., of rectilinear shape, thin in one dimension, and having two grilles in one of the large faces (R. 43); a radio, manufactured by Motorola, having a rectilinear case with rounded corners and edges (R. 45); and a radio, manufactured by Philco, having a rounded grille (R. 44). The Commissioner contended and the District Court agreed that the general form of the Harrison model, modified by the Motorola rounded edges and the Philco rounded grille form, anticipated the essentials of petitioner's design.

The District Court also found, as a fact, that the handle feature of plaintiff's design was simply a utilitarian feature, dictated by the mechanical re-

quirements, and hence adding nothing to the patentability of the design (R. 7). It also found that the handle feature had been anticipated in the prior art by a certain English patent (R. 7) and that, even in the absence of references to prior art, the expedient of rounding corners of cabinets was well-known (R. 7). The District Court thus held that petitioner's design lacked invention.

Petitioner based his appeal to the Court of Appeals chiefly on the contention that it was erroneous for the District Court to permit the combination of references in showing the state of the prior art. The Court of Appeals rejected this contention and affirmed the judgment of the District Court, dismissing the complaint.

ARGUMENT

The statutory test for the validity of a design patent, like that for a so-called mechanical patent, includes the requirement that the design exhibit invention. See *e.g., Smith* v. *Whitman Saddle Co.,* 148 U.S. 674, 679; *Application of Johnson,* 175 F. 2d 791 (C.C.P.A.). Petitioner asks this Court to override the unanimous agreement among two tribunals of the Patent Office and the two courts below that his box exhibits nothing in the way of invention that an ordinary designer, skilled in the art, could not have readily devised. We submit that the tribunals below were obviously correct.

Even aside from the particular examples of the prior art cited by the Commissioner, it is apparent

that petitioner's design includes little more than the rudimentary requirements of any electrical equipment housing. A phonograph needs a cabinet. Petitioner has built a box, rounding its edges. A phonograph cabinet needs a grille for the emission of sound. Petitioner has given it two grilles, rounding their corners and covering them with louvers. A mechanically wound phonograph needs a winding handle. Petitioner has equipped his box with a handle.

In other words, petitioner was faced with the engineering problem of housing a small portable phonograph. His solution, except for the expedient of rounding some edges and corners and choosing a particular grille, is the obvious and necessary response to the engineering exigencies. It is clear that a design for a manufactured article which is evoked as a necessary response to the engineering requirements of the article is not patentable as a design. See, *e.g., Hueter* v. *Compco Corp.,* 179 F. 2d 416 (C. A. 7); *Circle S Products Co.* v. *Powell Products,* 174 F. 2d 562 (C. A. 7); *Applied Arts Corp.* v. *Grand Rapids Metalcraft Corp.,* 67 F. 2d 428 (C. A. 6). Whether petitioner may have some basis for a mechanical patent on his method of encasing a phonograph in a small space is, of course, not material to the present case.

Beyond the minimum engineering exigencies, petitioner has rounded the edges of his box and the corners of its grilles. But one does not need

the District Court's finding that the expedient of rounding edges is old in the prior art (R. 7), to perceive that this expedient is not inventive. Indeed, this is the sort of thing that is likely to be found sketched in the margins of the copybooks of any mechanically-inclined schoolboy. Moreover, if invention is to be attributed to petitioner's rounded corners and double grilles, then it seems inescapable that every variation in the amount of curvature or in the number of grilles or the number of their louvers is equally inventive, which is absurd. It is often stated that obvious changes in arrangement and proportioning are not patentable. *E.g., Application of Stevens,* 173 F. 2d 1015 (C. C. P. A.).

So regarded, petitioner's design is unpatentable even without reference to the prior art; and since the question of invention here involved amounts to a question of the application of the statutory standard of invention to the facts of the case—clearly a question of law, see *A. & P. Tea Co.* v. *Supermarket Corp.,* 340 U. S. 147, 153-154, 156—it follows that evidence of the prior art is not prerequisite to a holding of lack of invention.

Nevertheless, such evidence was, as might be expected, abundant. The Commissioner relied particularly on the so-called Harrison Wholesale Co. catalogue reference (R. 43) as showing a portable radio case of rectilinear shape and having two grilles in one of the large faces; on a so-called Motorola radio (R. 45) as showing a rectilinear

case with rounded edges; and on a certain Philco radio model (R. 44) as showing the rounded form of grille. These three elements, all in the radio cabinet field, anticipate all the essentials of petitioner's design.

Petitioner attempts to attribute to the present case a significance broader than that of a decision on its particular facts, by arguing that the decision of the Court of Appeals was contrary to holdings of other circuits. He contends that a rule can be drawn from the cases to the effect that it is never proper for the Commissioner to base a decision of lack of invention or of anticipation in the prior art on the ground that various parts of the patent in suit existed separately in the prior art. No such conflict and no such rule exist.

There is no rule preventing the Commissioner from combining references, in appropriate cases, to show anticipation or lack of invention. This Court recently rejected just such a rule, in respect to mechanical patents, in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147. An analogous rejection should be applied in the case of design patents. The question, under the statute, is whether the given combination of previously known parts constitutes an inventive advance over the prior art, and obviously this question does not permit an answer based on rules formulated in advance. Many cases appear in the reports in which design patents have been denied or held

invalid on the ground that their component parts appear separately in the prior art. Among these cases are some cited by petitioner in support of his alleged rule. *E.g., Knapp* v. *Morss,* 150 U.S. 221 (mechanical patent for dress form); cf. *In re Faustmann,* 155 F. 2d 388 (C. C. P. A.) (design patent for typewriter keys and space bar); *Howell Co.* v. *Royal Metal Mfg. Co.,* 93 F. 2d 112 (C. A. 7) (design patent for metal two-piece chair frame).

Most of the cases holding that combinations of references do not invalidate the patent are cases in which either each of the combined parts has been substantially modified before being combined, *e.g., Application of Jennings,* 182 F. 2d 207 (C. C. P. A.), or else cases involving such designs as silverware or china patterns, where the number of combined parts is so multifarious as to allow room for artistic invention in the combination, *e.g., Graff, Washbourne & Dunn* v. *Webster,* 195 Fed. 522 (C.A. 2). The present case is of neither such type.

Petitioner contends that the Patent Office has discriminated against his application because of a change in Patent Office policy as to patentability. Nothing of any such change in policy appears in the record, nor does it appear that the alleged change in administrative policy was applied in a discriminatory manner rather than uniformly to all applicants while it was in effect.

CONCLUSION

This case involves no issue of significance beyond its particular facts, and the decision below is clearly correct. It is respectfully submitted that the petition for a writ of certiorari should be denied.

PHILIP B. PERLMAN,
Solicitor General.
HOLMES BALDRIDGE,
Assistant Attorney General.
SAMUEL D. SLADE,
T. S. L. PERLMAN,
Attorneys.

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